



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/726,093	10/04/96	FUCHS	SYP-116 (7783)

HM22/0420
TESTA HURWITZ AND THIBEAULT
PATENT ADMINISTRATOR
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

EXAMINER	
MARSCHEL, A	
ART UNIT	PAPER NUMBER
1634	21

DATE MAILED: 04/30/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/726,093

Applicant(s)

Fuchs et al.

Examiner

Ardin Marschel

Group Art Unit

1634



X Responsive to communication(s) filed on Jan 29, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) 32-51, 53-62, and 64-67 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

X Claim(s) 58-62 and 64-67 is/are allowed.

X Claim(s) 32-37, 39-51, 53, 55, and 56 is/are rejected.

X Claim(s) 38, 54, and 57 is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

X Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Pursuant to the timely filing of a CONTINUED PROSECUTION APPLICATION (CPA), the finality of the previous Office action, mailed 10/1/98, has been withdrawn.

Applicants' arguments, filed 1/29/99, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C.

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103(c) and potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 32-37, 39-51, 53, 55, and 56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Rose taken in view of Chen et al. (Ref. CN)., taken further in view of Nielsen et al. (P/N 5,539,082).

This rejection is reiterated and maintained from the previous office actions with the added disclosure of Nielsen et al. Nielsen et al. at column 6, lines 43-57, which recognizes that dsDNA targets inclusive of up to 60 base pairs form detectable hybridization complexes for hybridization assays.

Thus, it would have been obvious to someone of ordinary skill in the art to utilize PNA probes as instantly claimed for large target lengths in hybridization assays because Nielsen et al. suggests this ability as useful in such assays thus resulting in the practice of the instant invention when combined with Rose and Chen et al. as previously summarized.

Claims 38, 54, and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 58-62 and 64-67 are allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)305-3014 or (703) 308-4242.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

April 26, 1999


ARDIN H. MARSCHEL
PRIMARY EXAMINER